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10/716,633	11/20/2003	Fabrizio Ferrari	FERRARI3	6337

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EXAMINER

BONK, TERESA

ART UNIT PAPER NUMBER

3725

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/716,633

Applicant(s)

FERRARI ET AL.

Examiner

Teresa M. Bonk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 and 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 3/21/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Foreign patent document FR 2 818 189 A was not considered because a translated copy was not provided.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "124" has been used to designate both 124 and 125 in Figures 9, 10; reference character "24" has been used to designate both 24 and 23 in Figures 9, 10; and reference character "23" has been used to designate both 23 and 24 in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The abstract of the disclosure is objected to because reference numbers are present. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

Terminology is not consistent, e.g. page 9, line 7 reference number 180 is defined as "the component" while on page 9, lines 12 and 13 it is defined as "the plate".

Also, on page 10, line 14, reference number 224 is defines as "the seats," while on line 24 it is defined as "the holes."

On page 3, lines 25-26, continuing on page 4, line 1, "Said object is attained by the means defined in the main claim. Preferred embodiments of the means proposed therefore are indicated on the dependent claims." This statement does not add pertinent information to the summary of the invention.

On page 6, line 10 states that "respective holes" are reference number 18, "respective holes" should be reference number 13.

On page 8, line 24 states peg 123 as "the second peg" when there is no first peg.

On page 8, line 19 states "a first transverse peg 124" while on page 10, lines 1, 11, and 23 there are plural "pegs 124."

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5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 1, line 11-12, it states "at least one cavity (21) provided in the bar," "bar" should be "jaw" as shown in Figures 5, 8, and 11 and as defined in the specifications on page 7, lines 9-10 "In the inner face of the upper end of the jaw 12 there is also provided a cavity (21) intended to engage the ball (175)." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 1, there is no clear disclosure for the placement of the cavity (21) on the bar such that one of ordinary skill in the art could make and/or use the claimed invention. The disclosed specifications on page 7, lines 9-10 call for the cavity (21) to be on the jaw.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "at least one cavity (21) provided in the bar" in line 11-12. Claimed subject matter not enabling because the cavity is not provided in bar, but is placed in jaw structure as disclosed by the applicant in the specifications and drawings. Also regarding claim 1, it is not clear what the applicant is claiming due to the alternative limitation "or" on line 11: jaw or rigid part being claimed.

Claim 3 recites the limitation "its head" in line 18. Examiner does not understand and cannot determine what "its" refers to in the claimed subject matter; therefore, the scope of the claimed subject matter is indefinite. Claim 3 also recites the limitations "the corresponding plan profile" and "the adjacent bar portion" in lines 21-22. There is insufficient antecedent basis for these limitations in the claim.

Claims 4 and 5, recited the limitation "the profiles proximal end" in line 25 and lines 2-3, respectively. There is insufficient antecedent basis for these limitations in the claim.

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8. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

While several of the claims use "means," e.g. claims 1 and 6, they do not meet the 3-prong test in MPEP 2181 for purposes of this Office Action and; therefore, will not be treated at 35 U.S.C. 112 sixth paragraph. If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph applicant must either:

- (1) amend the claim to include the phrase "means for" or "steps for"; or
- (2) show that the claim limitation is written as a function to be performed and does not provide sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112 sixth paragraph.

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Tarasconi (US-PGPUB 2002/0053231 A1). Tarasconi discloses a toolholder unit for sheet metal

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bending brakes, comprising what is considered to be a bar 1 provided with at least one recess 10 forming with a jaw which is considered to be made up of members 20 and 30 of Tarasconi associated said jaws having a groove 81 to receive the shank 8 of the tool 7, there being provided elastic means 52 to maintain said jaw spaced from said recess and from the shank contained therein, and locking means to clamp said jaw against said shank, said locking means is considered to comprise: at least one slider 40 axially slidable within a seat 46 facing that side of the bar facing the jaw; at least one appendix 35 projecting from said slider beyond that side of the bar facing the jaw; at least one cavity 36 provided in the jaw 30, or in a part 5 rigid with it, to receive said appendix, and means of variable profile, considered to be the threaded connection discussed in column 4, paragraph 0040 to cause said slider to undergo controlled translations relative to said bar.

Claim 6 is also rejected under 35 U.S.C. 102(b) as being anticipated by Tarasconi. Tarasconi discloses means which is considered to be made up of members 50 on the jaw to cause the jaw to under go its maximum opening.

***Allowable Subject Matter***

11. Claim 2 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571) 272-1901. The examiner can normally be reached on M-F 7:30AM - 5PM with alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Teresa M. Bonk  
Examiner  
Art Unit 3725

  
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